

REMARKS

Claims 1, 4-7, 10-16 and 39-42 were pending in the present application. Claims 5 and 7 have been canceled, without prejudice; claims 1, 4, 6, 10, 14-16 and 42 have been amended; and claims 43 and 44 have been added. Accordingly, upon entry of the amendments presented herein, claims 1, 4, 6, 10-16, and 39-44 will be pending.

The amendments to claims 1, 4, 6, 10, 14-16 and 42 serve to correct informalities. Any amendments to the claims were done solely to more particularly point out and distinctly claim the subject matter of Applicants' invention in order to expedite the prosecution of the application. New claims 43 and 44 have been added to attend to formalities, *i.e.*, to avoid having multiple dependent claims depend from other multiple dependent claims. Indeed, claims 43 and 44 reflect originally filed claims 15 and 16. Support for the new claims and the amendments to the claims may be found throughout the specification, including the originally filed claims. *No new matter has been added.* Applicants reserve the right to pursue the claims as originally filed in this or a separate application(s).

Information Disclosure Statement

Applicants respectfully submit that an Information Disclosure Statement was filed on May 26, 2004. Applicants respectfully request that the Examiner consider the references cited on the PTO Form SB-08 and further acknowledge such consideration by initialing the PTO Form SB-08, as appropriate.

Specification

The Examiner has repeated his objection to the disclosure because "[o]n page 28, lines 11-14, of the specification applicants state 'As used herein, the term 'hybridizes under stringent conditions' is intended to describe conditions for hybridization and washing under which nucleotide sequences at least 60%

homologous to each other typically remain hybridized to each other...' Such a statement that nucleotide sequences which are 60% homologous would hybridize under stringent conditions is considered to be repugnant to what is known in the art."

The Examiner further states that Applicants failed to respond to this objection in the Amendment and Response of March 24, 2004. Applicants did, in fact, respond. In the Amendment and Response of March 24, 2004, Applicants stated that

Applicants respectfully traverse the foregoing objection to the specification. Applicants respectfully submit that the above statement is not repugnant to what is known in the art as evidenced by, for example, U.S. Patent No. 6,436,684, attached hereto as Appendix A. At column 26, lines 11-15, U.S. Patent No. 6,436,684 states that "[a]s used herein, the term 'hybridizes under stringent conditions' is intended to describe conditions for hybridization and washing under which nucleotide sequences encoding a peptide ***at least 60-70% homologous*** to each other typically remain hybridized to each other." Therefore, Applicants respectfully submit that this statement was acceptable to those of ordinary skill in the relevant art at the time the application was filed.

For the convenience of the Examiner, Applicants re-submit herein U.S. Patent No. 6,436,684 as Appendix A. Accordingly, Applicants respectfully request reconsideration and withdrawal of the foregoing objection to the specification.

Claim Objections

The Examiner has objected to claim 16 under 37 C.F.R. § 1.75(c) as being in improper form because claim 16 is a multiple dependent claim depending from another multiple dependent claim, claim 15. Accordingly, Applicants have amended claim 16 such that it is no longer a multiple dependent claim, *i.e.*, claim 16 is now only depending from claim 15, which has also been amended to avoid improper multiple dependency. This amendment is submitted without prejudice and without any intention to abandon the subject matter of the previously pending claim. In light of this amendment, Applicants respectfully request reconsideration and withdrawal of this objection.

The Examiner has also objected to claim 1 (and claims 10-16, depending from claim 1) and claim 7 for the recitation of the phrase "or a complement thereof." Applicants have amended claim 1 (and claim 6) to recite "or a full complement

thereof” as recommended by the Examiner. Additionally, in order to expedite examination, claim 7 has been cancelled without prejudice. Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

Rejection of Claims 15, 16 and 42 Under 35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 15, 16 and 42 under 35 U.S.C. §112, second paragraph, as being indefinite for “failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”

In particular, the Examiner has rejected claim 16 as reciting the limitation “said fine chemical” for which there is insufficient antecedent basis in claim 42. Applicants note that claim 16 has been amended herein such that it no longer depends from claim 42.

Additionally, claim 42 (and claim 15, depending from claim 42) is objected to because, according to the Examiner, the recitation “said cell” is inconsistent with the use of the term “host cell” in claim 13. As suggested by the Examiner and in order to expedite examination, Applicants have amended claim 42 (and claims 14 and 15) to recite “said host cell.”

In view of the foregoing amendments to the claims, the Examiner’s rejections have been rendered moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections under 35 U.S.C. §112, second paragraph.

Rejection of Claims 5 and 7 Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 5 and 7 under 35 U.S.C. §112, first paragraph, as “containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

In the interest of expediting examination, and in no way acquiescing to the validity of the Examiner’s rejection, Applicants have canceled claims 5 and 7, thereby rendering the foregoing rejection moot. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

CONCLUSION

Applicants believe that the foregoing amendments and remarks render the application in condition for allowance. If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 227-7400.

Respectfully submitted,

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Dated: **December 16, 2004**